REMARKS

In view of the following remarks, the Examiner is requested to withdraw the rejections and allow Claims 1–20, 22, 24-27, 29 and 31-32, the only claims pending and under examination in this application.

Claim 1 has been amended to limit the claim to a cement preparation claim, support for the amended language being found in the originally pending claims, as well as page 6, line 8 to page 7, line 4. Claim 2 has been amended to specify that the cement at least includes a liquid and solid component, support for this amendment being found in the specification at page 6, line 12. Claims 3, 4, 5, 8 and 9 have been amended to clarify the claim language only. Claim 10 has been amended to include a cement preparation step, support for this element being found in the same place as support for the above amendments to Claim 1. Claims 13, 15, 18 and 19 have been amended to clarify the claim language. Finally, Claims 20 and 27 have been amended to specify that the handling element is for preparing the cement, and the vibratory element is for applying vibration during preparation of the cement. As no new matter is added by way of these amendments, entry of the amendments by the Examiner is respectfully requested.

A number of claim objections were raised to Claims 1, 8, 9 and 20 and 27. In view of the above amendments, it is believed that these claim objections may be withdrawn.

The Office Action rejects Claims 1, 3, 5 and 10-32 under U.S.C. § 102(b) as being anticipated by U.S patent 6,149,655 (Constantz et al.).

Solely in order to expedite allowance of the present application, all of the Claims 1 and 10 have been amended to include the limitation that the cement is prepared in conjunction with vibration; and Claims 20 and 27 have been amended to limit the vibratory element to a pneumatic vibratory element.

As acknowledged by the Examiner (by not including Claim 2 in this rejection), the '655 patent neither teaches nor suggests preparing a cement in conjunction with vibration.

With respect to Claims 20 - 32, all of these claims require the use of a vibratory element that applies vibration during preparation of the cement. Nothing in the '655 patent teaches or suggests such a vibratory element. Accordingly, the '655 patent does not anticipate the subject matter of these claims.

Therefore, Claims 1, 3, 5 and 10-32 are not anticipated under 35 U.S.C. § 102(b) by U.S patent 6,149,655 and this rejection may be withdrawn.

The Office Action rejects Claims 20-25 and 27-32 under 35 U.S.C. § 102(b) as being anticipated by U.S patent 6,340,299 (Saito). As reviewed above, all of these claims require the presence of a vibratory element for use during cement preparation. Saito fails to teach such a vibratory element. Accordingly, this rejection may be withdrawn.

The Office Action rejects Claims 17-32 under 35 U.S.C. § 102(b) as being anticipated by, or under 35 U.S.C. § 103(a) as being obvious over, U.S patent 6,149, 655. With respect to Claims 20-32, the '655 patent is deficient in failing to teach or suggest a vibration element that is for preparation of the cement, which is an element of all of these claims. With respect to Claims 17-19, all of these claims require the use of vibration during preparation of the cement. As such, Claims 17-32 are not anticipated by, or obvious over, the '655 patent and this rejection may be withdrawn.

The Office Action rejects Claim 2 under 35 U.S.C. § 103(a) as being obvious over U.S patent 6,149, 655 in view of U.S. patent 5,639,238, asserting that the '238 patent teaches use of vibration during cement preparation.

In making this assertion regarding the '238 patent, the Examiner points to Col. 2, lines 34 to 42.

However, Col. 2, lines 34 to 42 read as follows:

> In another principal aspect, the present invention is a method for removing air bubbles from filling material. The methods include the steps of filling the caries lesion with the filling material; applying the tip of the apparatus to the material; and vibrating the material to remove the air bubbles. It is believed that this vibration lowers the viscosity of the filling material allowing better penetration into the prepared cavity and makes the material less likely to stick to the placement instrument.

The above passage does not teach the application of vibration to a cement while precursors of the cement are being combined, as is currently claimed. In the above passage, it appears that vibration is applied to completely prepared filling material following its introduction to the target site.

As such, the combined teaching of the '655 and '238 patents fails to teach or suggest the use of vibration in conjunction with the preparation of a cement.

Accordingly, Claim 2 is not obvious under 35 U.S.C. § 103(a) over the '655 patent in view of the '238 patent and this rejection may be withdrawn.

The Office Action rejects Claim 4 under 35 U.S.C. § 103(a) as being obvious over U.S patent 6,149, 655 in view of U.S. patent 6,832,988. As reviewed above, the '655 patent is deficient in failing to teach or suggest the element of the claims that requires vibration to be used in conjunction with preparation of the cement. As the '988 patent has been cited solely for its teaching of removal of diseased tissue by aspiration during vertebroplasty, the '988 patent fails to make up the fundamental deficiency in the '655 patent. As such, Claim 4 is not obvious under 35 U.S.C. § 103(a) over the '655 patent in view of the '988 patent and this rejection may be withdrawn.

The Office Action rejects Claims 6-9 under 35 U.S.C. § 103(a) as being obvious over U.S. patent 6,149, 655 in view of published U.S. patent application 2002/0183851. As reviewed above, the '655 patent is deficient in failing to teach or suggest the element of the claims that requires vibration to be used in conjunction with preparation of the cement. As the 2002/0183851 published application has been cited solely for its teaching of specific ranges, it fails to make up the fundamental deficiency in the '655 patent. As such, Claims 6-9 are not obvious under 35 U.S.C. § 103(a) over the '655 patent in view of the 2002/0183851 published application and this rejection may be withdrawn.

Claim 21 has been provisionally rejected for statutory type double patenting under 35 U.S.C. § 101 over Claims 18 of copending application serial no. 10/661,356. In view of the above amendments, this rejection may be withdrawn.

Claims 10-19 have been provisionally rejected under the judicially created doctrine of obviousness type double patenting over Claims 1-11 of copending application serial no. 10/661,356. In view of the enclosed Terminal disclaimer, this rejection may be withdrawn.

Claims 1-6, 10-25 and 27-32 have been provisionally rejected under the judicially created doctrine of obviousness type double patenting over Claims 1-26 of copending application serial no. 10/900,019. In view of the enclosed Terminal disclaimer, this rejection may be withdrawn.

CONCLUSION

In view of the amendments and arguments above, Applicants respectfully submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at (650) 327 3400.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 50-1078.

Respectfully submitted,

Date: June 24, 2005

By: _____
Bret E. Field
Registration No. 37,620

enc:

- Terminal Disclaimer over application serial no. 10/900,019
- Terminal Disclaimer over application serial no. 10/661,356

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